



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,062	05/14/2001	Michael A. Bass	32759US1	8583

116 7590 06/25/2003

PEARNE & GORDON LLP
526 SUPERIOR AVENUE EAST
SUITE 1200
CLEVELAND, OH 44114-1484

EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/855,062

Applicant(s)

BASS, MICHAEL A.

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-15, 22, 23 and 26-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-15, 22, 23 and 26-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Amendment received on April 14, 2003, paper number 13, is acknowledged and entered. Claims 24-25 are cancelled. Claim 1 is amended. New claims 37-40 are added. Currently claims 1-5, 7-15, and 22-23, 26-40 are pending for examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1-5, 7-8, 10-15, and 22-23, 26-38, and 40 filed on April 14, 2003, (see response pages 3-6) have been considered but they are not persuasive for following reasons:

(i) Overview: Both independent method (process) claims 1 and 38 appear to be very broad in nature. The recited steps comprise (1) providing a sign-it is very old and well-known practice that signs are provided to be used for selling goods/services or provide advertisement/information about products and services (2) purchasing a sign from a retail store-it is old and well-known that signs for selling products/services are available in retail stores (3) providing a website- it is old and well-known to provide a site to merchants/sellers (4) the seller placing the sign with an ID on the good or adjacent to the good-it is old and well-known to place signs on cars/properties (5) seller obtaining an ID and logging on a website using the ID to input information on the website. Further activities like purchaser viewing posted information about said good on websites, using preprinted instructions to carry out an activity like installing, playing, copying, posting information, etc. are old and well known. Subscribers do need a website address and an ID to access a website and do input information on a website for the use/information of others.

Art Unit: 3625

(ii) The limitations as indicated above are met by FSBO except that it does not disclose buying the signs from a retail store and then the seller accesses the web site. As analyzed in the earlier Office action, Berlin teaches explicitly that it is old and well-known to buy products, on Internet as well as from the physical stores, especially for those customers who do not feel comfortable in buying goods online (see at least col.1, line 7-col.4, line 14). In view of Berlin, it would be obvious to a person of an ordinary skill in the art at the time of the invention to combine the teachings of Berlin with that of FSBO for those customers who do feel comfortable in buying goods on Internet to modify FSBO to provide signs to be purchased conventionally from stores instead via electronic methods as explicitly taught in Berlin (see at least col.3, line 60-col.4, line 14). Regarding motivation to combine references. The examiner would also like to bring to the applicant's attention that his arguments, " From claim 1, it is now clear.....by first purchasing the "for sale " signAfter having purchasedhe wishes to sell " (see remarks, page 3, lines 19-22) are not consistent with the language of the claim 1. Claim 1 does not recite the limitation of "first purchasing the "for sale " sign before initiating an internet transaction for the sale of that good. See the following court cases which justify the motivation for combination of Berlin with FSBO :

In re Sheckler, 168 USPQ 716 (CCPA 1971)

It is not necessary that a reference actually suggest changes or possible improvements which applicant made.

In re Fine, 5 USPQ2d 1596 (CA FC 1988)

The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

Art Unit: 3625

In re Gershon, Goldberg, and Neiditch, 152 USPQ 602 (CCPA 1967)

"Although references do not disclose or suggest the existence of applicants' problem its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results."

In re Beattie, 24 USPQ2d 1040 (CA FC 1992)

"Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. "

In re Bode, Nolan, Baker, Mathias, and Pfaender, 193 USPQ 12 (CCPA 1977)

"Every patent application and reference relies to some extent on knowledge of persons skilled in art to complement that disclosed, in order that it be 35 U.S.C. 112 "enabling," and to satisfy requirements of reference under 35 U.S.C. 102."

In re Shepard, 138 USPQ 148 (CCPA 1963)

"In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the reasonable inferences which one skilled in the art would logically draw therefrom."

In re Jacoby, 135 USPQ 317 (CCPA 1962)

Art Unit: 3625

"Problem cannot be approached on basis that workers in the art would know only what they could read in references; those skilled in radiator art must be presumed to know something about radiators apart from what references disclose"

"it is immaterial that reference does not disclose specific function set forth in applicant's specification, since this is merely an additional attribute possessed by reference structure which would be obvious to one skilled in the art in a use which one skilled in the art, following teachings of prior art, might make of it"

In re Heck, 216 USPQ 1038 (Fed. Cir. 1983)

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain."

In re Prater, 162 USPQ 541 (CCPA 1969)

During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is quite different from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.

In re Bozek, 163 USPQ 545 (CCPA 1969)

"Test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art."

In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)

Art Unit: 3625

A prior art reference is **analogous** if the reference is in the field of applicant's endeavor or, if not, the reference is **reasonably pertinent** to the particular problem with which the inventor was concerned.

Lamont v. Berguer, 7 USPQ2d 1580 (BdPatApp&Int 1988)

Section 103 requires us to presume that the artisan has **full knowledge** of the prior art in his **field of endeavor** and the **ability to select** and utilize knowledge from **analogous arts**.

2.1. Applicant's arguments with respect to claims 9 and 39 filed on April 14, 2003, (see response pages 6-7) have been fully considered but are moot in view of new grounds of rejection FSBO/Berlin, Weiner et al. (US Patent 4,541,190), hereinafter referred to as Weiner.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1. Claims 1-3, 7-8, 13-14, 22-23, 26, 28-29, 32-38, and 40 are rejected under 35 U.S.C. 103(a) as being obvious over FSBO in view of Berlin.

With regards to claims 1-3, 7-8, 13-14, 22-23, 26, 28-29, 32-38, and 40, FSBO teaches a method for marketing a good comprising the steps of

providing a physical sign, said physical sign having a preprinted website address, a space for a unique identifier, and an indication that a good is for sale or rent (at least see pages 4 and 9, "Custom Yard Signs", and page 11)

Art Unit: 3625

providing a website located at said website address, said website permitting a seller, to post on said website under said unique identifier information about said good, said website

further permitting a prospective purchaser to enter said unique identifier in order to view said information (see at least pages 1, 2, 4, 6, 11. Note: On page 9, Ad# indicated in the Yard sign, and on page 11, Listing # correspond to the unique identifier of the product in the instant application.)

said seller conspicuously placing said sign physically on or adjacent said good for sale or rent, wherein said unique identifier corresponds specifically to said good on said website (at least see pages 4 and 9, "Custom Yard Signs", and page 11),

wherein when said seller logs onto said website said unique identifier is provided to said seller or entered by said seller at said website in connection with said seller posting said information on said website (see at least pages 1, 2, 4, 6, 11),

wherein said prospective purchaser views said posted information about said good on said website (see at least see pages 2, 3, 11, 12, and 13).

FSBO also discloses that the website provides the unique identifier to the seller to print it in said space on the said sign (see at least pages 1, 2, 4, 6, 11. Note: On page 9, Ad# indicated in the Yard sign, and on page 11, Listing # correspond to the unique identifier of the product in the instant application.), permitting the said purchaser to browse plurality of goods listed on said website by category and geographic location, and to view posted information therefore without reference to said unique identifier (see at least page 2. Note: the purchaser can look for many other houses-goods-in different states.), providing a container into which said seller can deposit a sheet of paper containing information about said good at (at least see pages 4 and 9, "Custom Yard Signs". Note: On page 9, "Brochures" denote the container for brochures.), promoting said website to the general consuming public (at least see, pages 2, 3, 11,12,13).

With regards to claims 22, 23, 26, 28, 29, 32, 33, 34, and 35, FSBO teaches all limitations of these claims (at least see, pages 2-13).

FSBO does not teach buying/selling physical signs in retail stores. FSBO discloses that physical signs are sold online. As per knowledge generally available there are many people who do not feel comfortable in buying goods on-line due to a number of reasons and they would like to buy directly from the retail stores. Berlin expressly teaches many people who do not feel comfortable in buying goods on-line due to a number of reasons and they would like to buy directly from the retail stores (see at least col.3, line 60-col.4, line 14). In view of the knowledge generally available and as clearly expressed in Berlin it would be obvious to a person of an ordinary skill in the art at the time of the invention to modify FSBO to include the feature of selling signs at retail stores so that those people who do not feel comfortable in making purchases online can buy the signs in retail stores. Note: The examiner would also like to bring to the applicant's attention that his arguments , " From claim 1, it is now clear.....by first purchasing the "for sale " signAfter having purchasedhe wishes to sell " (see remarks, page 3, lines 19-22) are not consistent with the language of the claim 1. Claim 1 does not recite the limitation of "first purchasing the "for sale " sign before initiating an Internet transaction for the sale of that good.

Please refer to the relevant court cases, as listed above under, "Response to Arguments", which justify the motivation for combination of Berlin with FSBO.

3.2. Claims 4-5, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over FSBO/Berlin and further in view of Chiquette (US Patent 5,920,634).

With regards to claims 4-5, and 30-31, FSBO/Berlin teaches a method for marketing good as disclosed and analyzed in claims 1 and 26 above. FSBO/Berlin does not disclose providing a description of said good and seller's personal contact information thereon. However,

Art Unit: 3625

in the same field of advertising display standards and technologies, Chiquette teaches providing a description of said good and seller's personal contact information thereon the sign (col.1, lines 14-24, "*.....The free standing advertising displays in common use today consist simply.....a visual panel hanging.....phone number...minimal detail about the thing being advertised*"). It would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify FSBO/Berlin to include providing a description of said good and seller's personal contact information thereon the sign. Doing so would make information available to consumers and give them some idea about the product being sold and also whom to contact for more information.

3.3. Claims 9 and 39 are rejected under 35 U.S.C. 103(a) as being obvious over FSBO/Berlin in view of Weiner.

With regards to claim 9, FSBO/Berline further discloses providing instructions to said seller about how to post information about said good on said website under said unique identifier (see FSBO at least page 3, 4, 6,). FSBO/Berlin also discloses preprinted web site addresses (see FSBO at least pages, 9, 11, "SeeHomePhoto.com", "FSBOAdvertisingService.com"). FSBO/Berlin does not disclose preprinting instructions for said seller about how to post said information on the sign.

Weiner teaches that physical signs include pre-printed instructions to provide intended guidelines to do certain things (see at least col.1, lines 36-col.2, line 68, Figs. 1 through 10 B. Note: In Weiner the intended purpose of the pre-printed instructions is to provide desired warning information to traffic). In view of Weiner, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify FSBO/Berlin to incorporate the feature of pre-printing intended instructions on the physical signs as explicitly taught in Weiner to display the desired information to the traffic because it would also enable FSBO/Berlin to

Art Unit: 3625

provide a set of guidelines or instructions to carry out an intended function for which the sign is being purchased. Further, FSBO/Berlin/Weiner does not disclose that the intended function of the pre-printed instructions is to instruct the seller as how to post said information on the Website. However, it has been held that a recitation with respect to the manner in which a claimed article/apparatus is intended to be employed does not differentiate the claimed article/apparatus from a prior art, in this case FSBO/Berlin/Weiner, satisfying the claimed structural limitations, see *Ex parte Xasham*, 2 USPQ2d 1647 (1987). In view of the findings of this court case, the examiner has not accorded patentable weight to the intended function of the sign to guide said seller about how to post said information on a website.

See also following court cases which justify combining Weiner with FSBO/Berlin. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971) "Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper.", " *In re Gershon, Goldberg, and Neiditch*, 152 USPQ 602 (CCPA 1967) " Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results.", *In re Wiseman*, 201 USPQ 658 (CCPA 1979) Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention, *In re Bode, Nolan, Baker, Mathias, and Pfaender*, 193 USPQ 12 (CCPA 1977) "Every patent application and reference relies to some extent on knowledge of persons skilled in art to complement that disclosed, in order that it be 35 U.S.C. 112 "enabling," and to satisfy

Art Unit: 3625

requirements of reference under 35 U.S.C. 102.", *In re Shepard*, 138 USPQ 148 (CCPA 1963)

"In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the reasonable inferences which one skilled in the art would logically draw therefrom." , *In re Jacoby*, 135 USPQ 317 (CCPA 1962) "Problem cannot be approached on basis that workers in the art would know only what they could read in references; those skilled in radiator art must be presumed to know something about radiators apart from what references disclose" "it is immaterial that reference does not disclose specific function set forth in applicant's specification, since this is merely an additional attribute possessed by reference structure which would be obvious to one skilled in the art in a use which one skilled in the art, following teachings of prior art, might make of it", *In re Bozek*, 163 USPQ 545 (CCPA 1969)"**Test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art.**" , *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) " A prior art reference is **analogous** if the reference is in the field of applicant's endeavor or, if not, the reference is **reasonably pertinent** to the particular problem with which the inventor was concerned ", *Lamont v. Berguer*, 7 USPQ2d 1580 (BdPatApp&Int 1988) Section 103 requires us to presume that the artisan has **full knowledge** of the prior art in his field of endeavor and the **ability to select** and utilize knowledge from analogous arts.

With regards to claim 39, its limitations being similar to that of claim 9, it is analyzed and rejected on the basis of same rationale.

Art Unit: 3625

3.4. Claims 10, 11, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over FSBO and further in view of Klingman (US Patent 5,799,285).

With regards to claims 10, 11, 12, and 15, FSBO/Berlin teaches a method of marketing a good as disclosed and analyzed in claim 1, above. FSBO/Berlin does not disclose making payments in the event of sale/purchase to seller directly or to the provider of web site so that provider can forward the payment to the seller, or to the provider from seller as a fee, or from the seller as a fee in connection with said posting of information on web site. As per knowledge generally available such payments in the event of sale/purchase to seller directly or to the provider of web site so that provider can forward the payment to the seller, or to the provider from seller as a fee, or from the seller as a fee in connection with said posting of information on web site are a common practice as expressed in Klingman (see at least. Col.4, lines 43-48, col.8, lines 6-8, col.9, lines 48-54, col.13, lines 31-33, and col.16, lines 2-16). It would have been obvious to a person of an ordinary skill in the art at the time of the invention to make payments in the event of sale/purchase to seller directly or to the provider of web site so that provider can forward the payment to the seller, or to the provider from seller as a fee, or from the seller as a fee in connection with said posting of information on web site as expressly demonstrated in Klingman.

3.5. Claim 27 is rejected under 35 U.S.C. 103(a) as being obvious over FSBO/Berlin in view of Mahoney et al. (US Patent 6,003,255), hereinafter, referred to as Mahoney.

With regards to claim 27, FSBO/Berlin teaches a method for marketing a good as disclosed and analyzed in claim 1, and 26 above. FSBO/Berlin discloses that the goods being sold are homes/apartments/real estate properties. Though the same method can be used for marketing other goods FSBO/Berlin does not disclose that. However, Mahoney expressly

Art Unit: 3625

discloses that physical signs are used to sell many different products including automobiles (see at least col.1, lines 1-67). In view of Mahoney, and as per knowledge generally available it would be obvious for a person of an ordinary skill in the art at the time of the invention to use physical signs in FSBO/Berlin to sell goods like automobiles also because physical advertising signs help to sell products (see at least Mahoney, col.1, lines 4-6, "... Advertising signs and/or displays are used in a number of different businesses and frequently serve as point of sale devices").

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4.1. US Pub.No.: 2001/0049986 A1 to Roberts et al. teaches that the intended use of pre-printed instructions are directed to help the user to carry out the intended purpose of informing the user as how to play the game (see at least page 8, paragraphs 0152-0153) which is similar to the intended purpose of guiding a user as how to post information on a website.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

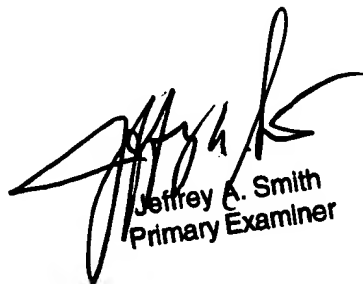
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Art Unit: 3625

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
June 20, 2003



Jeffrey A. Smith
Primary Examiner